

REMARKS

This application contains claims 1-16, the status of which is as follows:

- (a) Claims 2-10 and 12-15 are as originally filed.
- (b) Claims 1, 11, and 16 have been currently amended.

No new matter has been added. Reconsideration is respectfully requested.

The Applicant thanks Examiner Hoekstra for the courtesy of a personal interview with the Applicant's representative, Sanford T. Colb (Reg. No. 26,856), held in the USPTO on June 7, 2007, and a follow-up telephonic interview with the Applicant's representative, Benjamin M. Fishman (Reg. No. 57,030), held June 27, 2007. At the personal interview, Mr. Colb and the Examiner discussed a proposed amendment to claims 1, 11, and 16 to overcome the rejection of these claims under 35 U.S.C. 103(a) over US Patent 3,895,637 to Choy in view of US Patent 5,353,807 to DeMarco. The proposed amendment more positively recites the sliding of the gastrointestinal tool with respect to the guidewire. The Examiner agreed that the proposed amendment appears to obviate the rejection of the claims.

During the follow-up telephonic interview, Mr. Fishman proposed specific language for the amendment of claim 1 reflecting the substance of the amendment discussed during the interview with Mr. Colb (the discussed language appears in the amendment to claim 1 herein). The Examiner indicated that the proposed amendment appears to obviate the rejection of the claim over Choy in view of DeMarco. The Examiner indicated, however, that the proposed amendment appeared as though it would necessitate a rejection over Choy in view of PCT Publication WO 04/010858 to Gross et al., and that it would be in the Applicant's best interest to address the prior art in the amended claims. The Applicant draws the Examiner's attention to the Applicant's remarks regarding this PCT application, which can be found beginning on p. 8 below, and in the Rule 132 Declaration attached hereto.

Claim rejections under 35 U.S.C. 103

Claims 1-16 were rejected under 35 U.S.C. 103(a) as being anticipated by US Patent 3,895,637 to Choy in view of US Patent 5,353,807 to DeMarco. The Applicant respectfully submits that Choy neither teaches nor suggests three of the four elements

of independent claim 1, particularly as clarified by the proposed amendment discussed during the interviews, as mentioned above. The following table sets forth the three elements of claim 1 (marked to show the amendments made herein) that do not appear in Choy:

Claim 1	Choy
a guidewire	<u>Service tube 17 is not a guidewire</u> , and is not described as such by Choy.
a gastrointestinal tool formed with a bore, . . . wherein said gastrointestinal tool has at least one functionality selected from the group consisting of: diagnostic functionality[[,]] and therapeutic functionality	<u>Inflatable anchor member 18 is not a gastrointestinal tool having diagnostic or therapeutic functionality.</u> The sole function attributed by Choy to member 18 is advancement.
said guidewire passing through said bore such that said gastrointestinal tool slides over said guidewire, <u>wherein said guidewire is pulled by said inflatable device and following pulling of said guidewire by said inflatable device, said gastrointestinal tool slides relative to said guidewire</u>	Although service tube 17 (the putative "guidewire") passes through a bore of inflatable anchor member 18 (the putative "gastrointestinal tool"), <u>inflatable anchor member 18 does not slide over service tube 17.</u> The inflatable anchor member is in fact fixed to the service tube.

Service tube 17 of Choy is not a guidewire

As implied by its name, the function of "service tube" 17 of Choy is to service a desired area of the GI tract, either by using the tube itself (e.g., for removing waste materials), or by advancing a gastrointestinal tool, such as a camera, through the tube (see the Background section of Choy). There is no teaching or suggestion in Choy for service tube 17 to be used as a guidewire. A guidewire, as is well known in the art, is a flexible wire positioned in an organ, vessel, or duct for the purpose of directing the passage of a larger device threaded over or along its length. Furthermore, it appears that service tube 17 cannot function as a guidewire, and thus cannot anticipate claim 1

even structurally. As shown in Fig. 1 of Choy, two additional tubes (14 and 16) are coupled to service tube 17, making it difficult, if not impossible, to pass a tool over service tube 17.

*Inflatable anchor member 18 of Choy is not a
gastrointestinal tool having diagnostic or therapeutic functionality*

Inflatable anchor member 18 serves no diagnostic or therapeutic function, and is therefore not a gastrointestinal tool. The name of inflatable anchor member 18 was given by Choy himself (e.g., col. 3, line 7), and fittingly describes its sole functionality: anchoring to assist with advancement.

Inflatable anchor member 18 does not slide over service tube 17

Even if it were granted for the sake of argument that inflatable anchor member 18 is a tool having diagnostic or therapeutic functionality, anchor member 18 does not slide over service tube 17 (putatively corresponding to the guidewire). Instead, anchor member 18 is fixed to service tube 17. The sliding of the gastrointestinal tool over the guidewire is an essential feature of claim 1 which is entirely absent in Choy.

That anchor member 18 is fixed to service tube 17 is indicated by Choy in several places (emphasis added):

A multilumen flexible tube [12, which includes service tube 17] *is secured to* and extends through *the anchor member [18]*. . . (abstract).

The tubular member 12 extends coaxially through anchor member 18 and *is hermetically sealed to* the end walls 20 and 21 [of anchor member 18] (col. 3, lines 15-17).

The fixation of anchor member 18 to service tube 17 is also evident from the mode of advancement of Choy's device, as described with reference to Figs. 1-4 thereof (col. 4, lines 6-38). In particular, Choy describes that flexible tube 12 pulls deflated anchoring member 18 forward (to the right in the figures):

First the advancing member 19 . . . pull[s] tubular member 12 and anchor member 18 forwardly as shown in FIG. 2 (col. 4, lines 14-20).

Flexible tube 12 (which includes service tube 17) is able to pull anchor member 18 forward (to the right) because flexible tube 12 is fixed to anchor member 18.

As mentioned above, the Examiner agreed during the two interviews that the proposed amendment to claim 1 obviates the obviousness rejection of the claim 1 over Choy in view of DeMarco. The Applicant has made similar amendments to the other independent claims, claims 11 and 16, and thus respectfully submits that these claims are also in a condition for allowance. The remaining claims directly or indirectly depend from one of these claims, and thus also are in a condition for allowance, being of narrower scope than the claims from which they respectively depend.

Claim objections

Claims 1, 11, and 16 were objected to because of the informality of the inclusion of a comma between the phrase "diagnostic functionality" and the phrase "and therapeutic functionality." The Applicant has removed the comma, thereby obviating the objection.

Potential future rejections under 35 U.S.C. 103

As mentioned above, the Examiner suggested during the interview with Mr. Fishman that the claims as proposed to be amended appeared to the Examiner to be obvious under 35 U.S.C. 103(a) under Choy in view of PCT Publication WO 04/010858 to Gross et al. (which is assigned to the assignee of the present application, and shares a common inventor). The international application that published as the '858 PCT publication was filed on July 29, 2003, and claims priority from US Provisional Application 60/398,838, filed July 29, 2002, and US Application 10/302,897, filed November 25, 2002 (which issued as US Patent 6,988,986 to Gross et al.). The '858 PCT publication thus has three effective 102(e) priority dates for the respective subject matter included in the PCT publication and the two priority applications. The PCT application names Yosef Gross, Benad Goldwasser, and Oz Cabiri as inventors.

Without relating to the merits of the Examiner's position, the Applicant has attached hereto a Declaration under 37 CFR 1.132 that establishes that Benad Goldwasser, the sole inventor in the present application, was the sole inventor of the

subject matter shown in Fig. 17 of the '858 PCT publication and described with reference to Fig. 17 on pp. 10-11 thereof, and recited in claims 24-25 thereof. This subject matter is thus not available as prior art against the present application under 35 U.S.C. 102(e). The Applicant has reviewed the other subject matter of the '858 PCT publication, and does not believe that such other subject matter might reasonably serve as the basis of a rejection of any of the pending claims under 35 U.S.C. 103(a) in combination with Choy or DeMarco. The Applicant notes that the "guide member" described in the first full paragraph of p. 6 and the first full paragraph of p. 7 of the '858 PCT publication is for placement in the rectum of the patient, and is conceptually unrelated to the guidewire recited in the present claims despite the use of the word "guide."

The Applicant has also reviewed the two priority applications in order to be responsive to the Examiner's suggestion of a possible obviousness rejection in combination with Choy.

US Provisional Application 60/398,838 describes a self-propelled imaging system that uses two outwardly expandable elements for propulsion. The application does not describe a guidewire, or any element having guidewire-like functionality. The Applicant thus does not believe that the '838 application should serve as the basis of a rejection of any claims in the present application, either alone or in combination with Choy or DeMarco, which, as discussed above, neither teach nor suggest a guidewire as recited in the amended claims.

US Patent 6,988,986 describes an imaging system that uses a first expandable element and a second outwardly expandable element mounted on a carrier tube. The carrier tube does not function as a guidewire as recited in the amended claims, and the patent does not otherwise describe a guidewire, or any element having guidewire-like functionality. The Applicant thus does not believe that the '986 patent should serve as the basis of a rejection of any claims in the present application, either alone or in combination with Choy or DeMarco, which, as discussed above, neither teach nor suggest a guidewire as recited in the amended claims.

The Applicant believes the amendments and remarks presented hereinabove to be fully responsive to all of the grounds of rejection and objection raised by the

Examiner. In view of these amendments and remarks, the Applicant respectfully submits that all of the claims in the present application are now in order for allowance. Notice to this effect is respectfully requested.

Respectfully submitted,

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